

## FOR DISCUSSION PURPOSES ONLY

- producing a fibrous medium from a paper suspension;
- depositing on the fibrous medium between one and five grams per square meter (1 and 5 g/m<sup>2</sup>) of a composition based on specific pigment chosen from the group consisting exclusively of silica and precipitated calcium carbonate;
- drying the fibrous medium which has been deposited;
- coating the covered fibrous medium with at least one conventional surface coat intended to be printed by gravure or flexographic printing, the composition of which not containing silica;
- drying the paper or board created by said drying and coating steps; and
- calendering the paper or board obtained.

## REMARKS

The above-captioned patent application has been carefully reviewed in light of the Office Action to which this Amendment is responsive.

Claims 1-8 are pending. Claims 1 and 3-7 have been rejected under 35 USC §102(b) as being anticipated by Suzuki et al. (U.S. Patent No. 4,298,652). Claims 2 and 8 have also been rejected under 35 USC §103(a) as being over Suzuki et al. in view of Li (U.S. Patent No. 6,183,844). Applicants' respectfully request reconsideration based on the amended claims and the following discussion.

Applicants' would like to again point out the perceived novelty of the present invention. The present invention relates to at least one paper or board consisting of a fibrous medium that is coated with a conventional surface coat and intended to be printed by gravure or flexographic printing and of process for manufacture of same. The paper or board includes an inner coat of a composition based on specific pigments in which the inner coat is deposited in an amount from one to five grams per square meter (1 to 5 g/m<sup>2</sup>). According to the invention, the conventional surface coat does not contain silica and the composition of the inner coat includes at least one specific pigment in which the at least one pigment is chosen exclusively from the group consisting of silica and precipitated calcium carbonate (PCC).

In the case of the cited prior art, Suzuki et al. (U.S. Patent No. 4,298,652) describes a paper having a topcoat composition that is intended to be printed by

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gravure or flexographic printing. As described, the paper is coated with a two-coating composition (A or B) which always contains as a specific pigment, natural ground carbonate with a specific surface area. As explained previously, the presence of natural ground calcium carbonate in the topcoat contributes to improving porosity.

The present invention, however, includes an inner coat with specific pigments consisting of silica, PCC (precipitated calcium carbonate) or a mixture thereof. Natural calcium carbonate is never used in the inner coat as part of the specific pigment.

Claims 1 and 4 have been specifically amended to note that the at least one pigment of the inner coat exclusively contains silica, PCC and/or a mixture of each. Though the inner coat can include a binder and immolulizing agents, such as described in compositions A, B the pigments do not include anything other than PCC and silica.

Turning to the prior art rejections, Applicants' disagree with Examiner's rejection of Claims 1 and 4 under 35 USC §102 of Suzuki. In order to maintain an anticipation rejection under the Statute, each and every essentially claimed element must be found in the cited reference. In examining Suzuki et al., it is clear this reference does not contain an inner coat consisting of at least one specific pigment which exclusively includes at least one of PCC and silica.

Because this reference fails to include all essential elements of Claims 1 and 4, there can be no anticipation under the Statute of these claims. Claims 3 and 5-7 are also believed allowable for the same reasons. Reconsideration is respectfully requested.

Claims 2 and 8 have also been rejected under 35 USC §103(a) based on the combination of Suzuki and Li. Applicants' respectfully request reconsideration based on the following.

In order to establish a *prima facie* obviousness rejection under the Statute, each and every essentially claimed element must be found either singly, or in combination, in the cited art. Those elements which are not found in the cited references must be notoriously well known in the field.

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As previously noted, Suzuki fails to recite or suggest a paper or board that includes an inner coat consisting of at least one specific pigment consisting exclusively of PCC and silica. The secondary reference to Li does not add this feature. Therefore, it is believed there can be no obviousness under the Statute.

In summary, it is believed the above-captioned patent is in an allowable condition and such allowance is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

**FOR DISCUSSION PURPOSES ONLY****"VERSION WITH MARKINGS TO SHOW CHANGES MADE."****In the Claims:**

Claims 1 and 4 have been amended as follows:

1. (Three Times Amended) At least one of a paper and a board consisting of a fibrous medium coated with at least one conventional surface coat *remove* [intended to be] printed by gravure or flexographic printing, and including, between the fibrous medium and the conventional surface coat, ~~an~~ inner coat of a composition based on specific pigments, said inner coat being deposited in an amount from one to five grams per square meter (1 to 5 g/m<sup>2</sup>), wherein:

- the composition of the conventional surface coat does not contain silica;
- and the composition of the inner coat includes at least one specific pigment chosen exclusively from the group consisting of silica and precipitated calcium carbonate (PCC).

4. (Three Times Amended) A process for the manufacture of a paper or a board, intended to be printed by gravure or flexographic printing, which consists of the followings steps:

- producing a fibrous medium from a paper suspension;
- depositing on the fibrous medium between one and five grams per square meter (1 and 5 g/m<sup>2</sup>) of a composition based on specific pigment chosen from the group consisting exclusively of silica and precipitated calcium carbonate;
- drying the fibrous medium which has been deposited;
- coating the covered fibrous medium with at least one conventional surface coat *remove,* [intended to be printed] by gravure or flexographic printing, the composition of which not containing silica;
- drying the paper or board created by said drying and coating steps; and
- calendering the paper or board obtained.